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In re Application of
WU, SHIN-TSON, *et al.*
Application No. 09/285,937
Filed: 04/02/1999
For: DOPANTS FOR LIQUID-CRYSTAL
DEVICES

DECISION REFUSING STATUS
UNDER 37 C.F.R. §1.47(a)

This is in response to the Petition Under 37 C.F.R. §1.47(a) filed on August 3, 1999.

HISTORY

The above-identified application was filed on April 2, 1999 naming and as joint inventors Shin-Tson Wu, Seth Marder, and Qing T. Zhang. However, the declaration was not signed by all of the inventors. Accordingly, a notice to file missing parts (hereinafter "the notice") was mailed to the address of record on May 4, 1999.¹ Petitioner then filed this response to the notice (which included payment of the deficient fees, a request for a month extension of time, and this petition) on August 3, 1999.

LAW

§ 1.47 Filing when an inventor refuses to sign or cannot be reached.

(a) If a joint inventor refuses to join in an application for patent or cannot be found or reached after diligent effort, the application may be made by the other inventor on behalf of himself or herself and the nonsigning inventor. The oath or declaration in such an application must be accompanied by a petition including proof of the pertinent facts, the fee set forth in §1.17(l) and the last known address of the nonsigning inventor. The Patent and Trademark Office shall, except in a continued prosecution application under §1.53(d), forward notice of the filing of the application to the nonsigning inventor at said address and publish notice of the filing of the application in the Official Gazette. The nonsigning inventor may subsequently join in the application on filing an oath or declaration complying with §1.63.

ANALYSIS

As noted in the rule above, proof of the pertinent facts surrounding Petitioner's inability to locate absent joint inventor(s) must be supplied with a petition under Rule 1.47. To further elaborate upon the meaning of that requirement, Petitioner is urged to note the M.P.E.P. 409.03(d) (Proof of Unavailability or Refusal), which states:

"Where inability to find or reach a nonsigning inventor 'after diligent effort' is the reason for filing under 37 CFR 1.47, an affidavit or declaration of facts

¹ The statutory filing fee was missing as well.

should be submitted that fully describes the exact facts which are relied on to establish that a diligent effort was made...[t]he affidavit or declaration of facts must be signed, where at all possible, by a person having firsthand knowledge of the facts recited therein. Statements based on hearsay will not normally be accepted. Copies of documentary evidence such as certified mail return receipt, cover letter of instructions, telegrams, etc., that support a finding that the nonsigning inventor could not be found or reached should be made part of the affidavit or declaration. It is important that the affidavit or declaration contain statements of fact as opposed to conclusions." *Emphasis added.*

Nothing within the meaning of the above reference has been included with this petition. Therefore, Petitioner cannot be said to have satisfied the requirement of Rule 1.47 of supplying a declaration "accompanied by a petition including proof of the pertinent facts."²

This petition is accordingly *dismissed*.


Further correspondence with respect to this matter should be addressed as follows:

By mail: Assistant Commissioner for Patents
Box DAC
Washington, D.C. 20231

By FAX: (703) 308-6916
Attn: Special Program Law Office

By hand: Crystal Plaza Four, Suite 3C23
2201 S. Clark Place
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Telephone inquiries related to this decision should be directed to Petitions Attorney Scott Ledford at (703) 306-5593.


Office of Petitions
Office of the Deputy Assistant Commissioner
for Patent Policy and Projects

² 37 C.F.R. §1.47(a).